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OFFICE OF PETITIONS

In re Application of:

Murphy

Application No. 09/877,240

: ON PETITION

Filed: June 11, 2001

PGPUB 20020036792A1 3/28/02.

Docket No.: 001223.00014

This is a decision on the petition filed November 1, 2004, under 37 CFR 1.182 asking that the USPTO determine whether the above-identified application is properly termed a divisional or a continuation-in-part (CIP) of a prior application.

The petition is **dismissed as immaterial**.

As background, the above-identified non-provisional application as filed, styled itself in both the transmittal latter and also in the first line of the specification as a divisional of prior non-provisional application no. 09/506,925 ('925) filed February 18, 2000, which in turn was asserted in the specification to be a divisional of prior non provisional application no. 09/184,972 filed November 3, 1998, which, in turn, was asserted to be a divisional of prior non provisional application no. 08/555,911('911) filed November 13, 1995.

The relationships required by 37 CFR 1.78(a)(2)(i) were thus determined by applicant, not the USPTO, in the priority claim that was recognized by the USPTO as shown by the filing receipt mailed December 17, 2001, and the appropriate entry on corresponding U.S. Patent Application Publication No. US 20020036791A1 published March 28, 2002.

Petitioner now wishes the USPTO to compare, on petition, the specifications of the aforementioned '925 application and the instant '238 application, and itself make the determination in the first instance that the more correct relationship is that of CIP rather than divisional. Petitioner observes that if the CIP relationship is determined to be governing herein by the USPTO, then the assignment executed by Murphy of the parent '911 application recorded at reel 8316 frame 76 conveying his entire rights title and interest to Netfax incorporated ("Netfax") will not carry to the instant application, such that Murphy would be presumed to retain his ownership interest in this application pursuant to 37 CFR 3.73(a). See e.g., MPEP 201.12.

It should be noted that 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (1903). By its terms, 37 CFR 1.182 applies only when no other regulation speaks to the issue. However, 37 CFR 1.78(a)(2) specifically provides for benefit claims of prior divisional, or even prior CIP applications. Furthermore, inspection of the record herein reveals that the power of attorney comes directly from the named inventor. See the combined declaration power of

attorney filed December 10, 2001; revocation and power of attorney coupled with a change of address likewise executed by the named inventor filed July 29, 2004. There is no evidence that any putative assignee of the entire interest has sought to intervene herein and make the required showing to control prosecution to the exclusion of the named inventor within the meaning of 37 CFR 3.73(b) and MPEP 324. Accordingly, Murphy, as the named inventor, has an undiminished right to prosecute this application, including the right to file a timely amendment(s) to the priority claim of record. See 37 CFR 3.73(a). Thus, since Murphy contends that the relationship between the instant application and the '911 non-provisional requires correction, then a petition under 37 CFR 1.182—or for that matter 37 CFR 1.78-- is not required herein as a condition of amending the relationship. Rather, Murphy *himself* may propose such a conforming amendment under 37 CFR 1.111 and 1.121 consistent with his own determination, or changed determination, of the relationship at issue. See the following question and answer posted on the USPTO web site at <http://www.uspto.gov/web/offices/dcom/olia/aipa/18monthfaq.htm#cx>:

CX6. Applicant filed an application with a benefit claim to an earlier copending nonprovisional application. The benefit claim was filed within four months from the actual filing date of the application, but the relationship of the applications was designated as "continuation." If applicant wants to change the relationship to "continuation-in-part," would a petition under 37 CFR 1.78(a)(3) and the surcharge set forth in 37 CFR 1.17(t) be required? (added 4Feb2005)

No, the petition under 37 CFR 1.78(a)(3) and the surcharge would not be required when applicant is changing the relationship in a benefit claim from "continuation" (or "divisional") to "continuation-in-part" or from "continuation-in-part" to "continuation" (or "divisional"), or from "continuation" to "divisional," because the Office was able to schedule the application for publication with the relationship given.

Accordingly, while the patent statute and rules of practice do not require that the USPTO perform the requested determination on behalf of petitioner, should petitioner wish to file an amendment changing his own statement of the relationship at issue, he is free to do so, subject, of course, to the stage of prosecution the application is in. See MPEP 201.11(F).

This application is being referred to the Technology Center.

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217



Brian Hearn
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Office of Petitions